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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/626,418

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Eric C. Anderson

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EXAMINER

SOLOMON, GARY L

ART UNIT

PAPER NUMBER

2615

DATE MAILED: 05/12/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/626,418

Applicant(s)

ANDERSON ET AL.

Examiner

Gary L Solomon

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2-13-04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-18 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-18 and 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-7, 9-18, and 20-23 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Wasula (US 2002/0054224).

For claims 1 and 12, Wasula discloses a method and system (Figure 1) for allowing a user to select actions (Figure 6) to be taken by a server (Figure 1, Element 70) when uploading images from a hand-held image capture device (Figure 3, Element 460 and Section 0022), the method and system comprising the steps of:

(a) downloading an action list (Figure 6; The profile table shown in Figure 6 and cited in Figure 2B element 220 shall be referenced to as Wasula's action list) from the server to the image capture device after the image capture establishes a connection with the server (**Section 27**), the action list including one or more items representing actions that the server should take with respect to uploaded images (Figure 6; The server uses the action list to determine image transfer properties, which are listed in Figure 3A.

(b) displaying the action list to the user on the image capture device after the user initiates an image upload process (Figure 2B; After the camera is connected to the host computer and/or server, which begins the image upload process, the host computer will save a new profile table to the camera. (Sections 29-33),

(c) after the user selects at least one of the items in the action list, sending the images and the selected action list item from the image capture device to the server (Figure 4 and 6; When the user of the camera selects the profile for which the selected photos are placed, the server will update itself with the information from the digital camera. Section 27); and

(d) performing the action on the uploaded images specified by the selected action item (Figure 3A; The server will store the image where the user selects such as in File Folder c:\SAM'S 1st BIRTHDAY).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7, 9-18, and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Safai (US 6,167,469) in view of Wasula (US 2002/0054224).

For claims 1 and 12, Safai discloses a method and system for allowing a user to select actions to be taken by a server when uploading images from a hand-held image capture device

(Column 3, Lines 47-67; Figure 3; The graphical user interface illustrated is viewed on the digital camera and allows the user to tell the server or host computer to mail print, edit, or to change settings. Mail and Print are actions that are taken the server. The server prints the images and mails via email (Column 3, Lines 47-63)), the method and system comprising the steps of:

(a) storing an action list on the image capture device (Figure 3), the action list including one or more items representing actions that the server should take with respect to uploaded images (The graphical user interface illustrated is viewed on the digital camera and allows the user to tell the server or host computer to mail print, edit, or to change settings. Mail and Print are actions that are taken the server. The server prints the images and mails via email (Column 3, Lines 47-63))

However, Safai does not teach the applicant's newly added limitation **“downloading an action list from the server to the image capture device after the image capture device establishes a connection with the server.”** The newly added limitation adds further limitation to the claim in the fact the following steps regarding the action list must be downloaded from the server.

Safai's digital camera is in connection with a server. However, the server does not send any type of action list to the camera.

Nevertheless, Wasula teaches a digital image transfer device, which uploads, pictures and downloads user created profile data in the form of an action list to the digital camera from a host computer (Section 27).

Using the idea of Wasula to send user profile information that is created or edited on the host computer to the digital camera, it would have been obvious for one skilled in the art to have been motivated to download an action list of Safai from the server or host computer and store it on the digital camera for the advantage of creating customized user profiles on a computer that are storable on a portable digital camera as suggested by Wasula (Section 27). The further limitations (b, c, and d) of the current claim would then therefore be met by the obvious combination of the Safai and Wasula teachings.

(b) displaying the action list to the user on the image capture device after the user initiates an image upload process (Figure 4A; After the user has decided to mail the picture, which means the image upload process has begun. The picture must be uploaded to the internet in order to be mailed.)

(c) after the user selects at least one of the items in the action list, sending the images and the selected action list item from the image capture device to the server (Column 2, Lines 29-42; Column 2, Lines 59-64; Column3, Lines 46-64); and

(d) performing the action on the uploaded images specified by the selected action item (Figure 5A and 5B; Column 2, Lines 59-64; Column3, Lines 46-64).

For claims 2 and 13, Wasula and Safai disclose all the previous limitations, and Safai further teaches including the step of providing the server as part of a photo-sharing service website (Column 15, Lines 27-29; The maintenance is done on a photo sharing website.).

For claims 3 and 14, Safai discloses all the previous limitations further including the step of providing the action list with at least one of a print item, a store item that instructs the server

where to store the images, a send item that instructs the server where to send the images (Figure 3; Figure 4B Illustrates what email address the server is supposed to send the mail to.).

For claims 4 and 15, Wasula and Safai disclose all the previous limitations, and Safai further teaches including the step of providing that the store item (Figure 4F, Element 476) instructs the server to store the images within the photo-sharing service website (Figure 4F, Element 466; When a picture is e-mailed it is stored in a email mail box until the addressee of the email decides to delete it.).

For claims 5 and 16, Wasula and Safai disclose all the previous limitations, and Safai further teaches including the step of providing that the store item instructs the server to store the images to a location external (Figure 4E, Element 456) to the photo-sharing website (Figure 4F, Element 466 Also in Column 3, Lines 47-64, the website contains a service that will print the pictures and mail them to a postal address. Therefore, the pictures can actually be sent from a digital camera to a postal address.).

For claims 6 and 17, Wasula and Safai disclose all the previous limitations, and Safai further teaches including the step of providing an e-mail address as the send item in the action list (Figure 4F, Element 476; Column 9, Lines 14-25).

For claims 7 and 18, Wasula and Safai disclose all the previous limitations, and Safai further teaches including the step of allowing the user to create the action list on the image capture device (Figure 4B, The user is using a touch screen to write the email address. The email address or addresses are the actions of where the picture is to be emailed.).

Claims 8 and 19 have been cancelled.

For claims 9 and 20, Wasula and Safai disclose all the previous limitations, and Safai further teaches including the steps of creating a user account for the user the first time the image capture device establishes a connection with the server, and creating a default action list for the user (Column 15, Lines 16-27; After the user establishes a connection with the server, Line 18, they establish account on the storage device, Line 19. The server for user to fill in such as provides default account information listed in Column 15. This is interpreted by the examiner as a default action list.).

6. Claims 10-11 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Safai (US 6,167,469) in view of Wasula (US 2002/0054224) in view of Steinberg (US 6,006,039).

For claims 10 and 21, Wasula and Safai disclose all the previous limitations, but lack teaching further including the step of allowing the user to manually create the action list on the photo-sharing service website by navigating to the photo-sharing service website using a web browser and manually creating the action list.

However Steinberg discloses a method of allowing the user to manually create the entering of “text and graphics” (Column 4, Line 56). It would have then been obvious for one skilled in the art to create the action list form the computer (Column 1, Lines 62-65), which consists of “text and graphics” as suggested by Steinberg.

Creating an action list or sending information to be displayed on a camera from a computer through external means as an obvious variation of Steinberg would be obvious addition to Safai’s system to one of ordinary skill in the art in order to allow the user of the digital camera to create his or her own action list that would tell the camera to perform actions external to the

camera. Therefore, it would have been obvious to one of ordinary skill in the art to have been motivated to configure the teachings of sending text and graphics to a digital through a computer (Column 1, Lines 65-67) as suggested Steinberg for the advantage of allowing the user to transfer his own action list to perform operations external to the camera such as printing or email.

For claims 11 and 22, Steinberg further discloses an obvious variation of the previous limitations further including the step of automatically creating the action list on the photo-sharing service website in response to the user actions performed on the photo sharing website though a web browser (Column 1, Lines 65 through Column 2, Lines 1-55; Column 4, Lines 32-56).

As previously stated in the rejections for claims 10 and 21, the entering of “text and graphics” through external means is taught by Steinberg. Automatically creating the action list on the photo-sharing service website in response to the user actions performed on the photo sharing website though a web browser is an obvious variation of Steinberg’s method and encompasses entering text and graphics through an external means. Moreover, the Wasula reference as taught in Section 27 explicitly teaches sending information from the server to the digital camera.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to configure the teachings of entering text and graphical data (Column1, Lines 65-67) as suggested by Steinberg with the system of Safai (Figure 3-Figure 4)) for the advantage of automatically creating an action list to perform operations external to the camera such as printing or email.

For claim 23, Safai discloses a method and system for allowing a user to select actions to be taken by a server when uploading images from a hand-held image capture device (Column 3, Lines 47-67; Figure 3; The graphical user interface illustrated is viewed on the digital camera and allows the user to tell the server or host computer to mail print, edit, or to change settings. Mail and Print are actions that are taken the server. The server prints the images and mails via email (Column 3, Lines 47-63)), the method and system comprising the steps of:

(a) storing an action list on the image capture device (Figure 3), the action list including one or more items representing actions that the server should take with respect to uploaded images (The graphical user interface illustrated is viewed on the digital camera and allows the user to tell the server or host computer to mail print, edit, or to change settings. Mail and Print are actions that are taken the server. The server prints the images and mails via email (Column 3, Lines 47-63)),

In the Wasula teaching, Figure 3A specifies a storage location (Sam's 1st Birthday). This meets the further limitation of "including any combination of specifying a storage location."

(b) displaying the action list to the user on the image capture device after the user initiates an image upload process (Figure 4A; After the user has decided to mail the picture, which means the image upload process has begun. The picture must be uploaded to the internet in order to be mailed.)

(c) after the user selects at least one of the items in the action list, sending the images and the selected action list item from the image capture device to the server (Column 2, Lines 29-42; Column 2, Lines 59-64; Column3, Lines 46-64); and

(d) performing the action on the uploaded images specified by the selected action

item (Figure 5A and 5B; Column 2, Lines 59-64; Column3, Lines 46-64).

However, Safai does not teach the applicant's newly added limitation "downloading an action list from the server to the image capture device after the image capture device establishes a connection with the server. The newly added limitation adds further limitation to the claim in the fact the following steps regarding the action list must be downloaded from the server.

Safai's digital camera is in connection with a server. However, the server does not send any type of action list to the camera.

Nevertheless, Wasula teaches a digital image transfer device, which uploads, pictures and downloads user created profile data in the form of an action list to the digital camera from a host computer (Section 27).

In the Wasula teaching, Figure 3A specifies a storage location (Sam's 1st Birthday). This meets the further limitation of "including any combination of specifying a storage location." It is clear that Safai teaches storing the picture in an email storage sending to a regular postal address, which is also a storage location. There is further teaching in Wasula about image compression format. When in any image is compressed, it is well known there is analyzation and calculation performed on the image.

Using the idea of Wasula to send user profile information that is created or edited on the host computer to the digital camera, it would have been obvious for one skilled in the art to have been motivated to download an action list from the server or host computer and store it on the digital camera for the advantage of creating customized user profiles on a computer that are storable on a portable digital camera as suggested by Wasula (Section 27) . The further

limitations (b, c, and d) of the current claim would then therefore be met by the obvious combination of the Safai and Wasula teachings.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

8. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary L Solomon whose telephone number is (703)-305-4370.

10. The examiner can normally be reached on Monday - Friday 8:00 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, Vu Le can be reached on (703)-308-6613.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Art Unit: 2615

Or faxed to:


(703) 872-9314, (for informal or draft communications, please label
"Proposed" or "Draft")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be
directed to the customer service number **(703) 306-0377**.

Gary Lee Solomon

May 4, 2004


VULE
PRIMARY EXAM